

## **REMARKS/ARGUMENTS**

Claims 1, 3-12, 14-18, and 20 are pending in this application, with claims 1, 14, and 18 being the only independent claims. Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

Each of the independent claims recites “at least two of said artificial fingernails are arranged substantially perpendicularly to said bottom surface such that one of said longitudinal ends of each of said at least two of said artificial fingernails faces a front of said package”.

Claims 1, 3-5, 9-18, and 20 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,791,482 (“*Murphy*”) in view of U.S. Patent No. 4,282,975 (“*Ovadia*”).

Claims 6-8 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Murphy* in view of U.S. Patent No. 4,106,614 (“*Aylott*”).

None of the references, alone or in combination, teach or suggest that one of the longitudinal ends of each of said at least two of said artificial fingernails is arranged substantially perpendicularly to said bottom surface and faces said transparent portion on the front of said package, as now required by each of the independent claims 1, 14, and 18.

The rejection is based on a combination of the artificial nail package disclosed by *Murphy* and the jewelry display holder disclosed by *Ovadia*. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective

functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396.

The Examiner acknowledges that *Murphy* fails to disclose a sponge-like material with a slit for receiving the artificial nails. However, *Murphy* also fails to disclose the arrangement of the nails so that the at least two of the nails are retained "in a position substantially perpendicular to said bottom surface", "so that one of the ends of the nail faces the front of said package". To accomplish this, *Murphy* would have to be altered to accommodate the thickness needed to orient the nails as claimed. This alteration increases the thickness of the package which is undesirable because the increased thickness reduces the number of packages that can be arranged or stacked in a row of a given length. As indicated in the attached declaration of Grace Tallon, there was no recognized need to arrange the nails so that they are perpendicular to the front surface at the time of the invention.

*Aylott* discloses an artificial nail package similar to that disclosed by *Murphy* in that the nails are arranged so that the tops of the nails face the front of the package.

*Ovadia* merely discloses a holder having slits used for receiving jewelry such as rings. Since *Ovadia* discloses a holder for a ring, the arrangement of *Ovadia* fails to teach or suggest or provide any reason to hold artificial fingernails in a manner so as to showcase the longitudinal

ends of the artificial nails through the front of an artificial nail package. Accordingly, the teachings of *Ovadia* fail to provide a reason for incorporating the holder of *Ovadia* into the artificial nail package disclosed by *Murphy* or *Aylott*. At the time of the invention, there was no recognized need to arrange the nails so that they are perpendicular to the front surface at the time of the invention. Accordingly, the skilled in the art would have no reason to solve a problem of which they are unaware.

The Examiner argues that the way artificial fingernails are arranged in the holding material is merely design choice. The Examiner further states that when there is a design need or market pressure to solve a problem, a person of ordinary skill has good reason to pursue known options within his or her technical grasp. However, as stated above and in the attached declaration by Grace Tallon, (1) the claimed arrangement is more than design choice because it requires alteration of the thickness of the package of *Murphy* to accommodate the claimed arrangement of the nails, and (2) there was no design need or market pressure to provide the claimed arrangement of the nails. Rather, this idea was generated by the inventor alone. "[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103." *In re Sponnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969). In this case, the inventor realized a problem with existing artificial nail packages and provided the solution. The invention relates, at least partially, to the identification of the source of the problem, i.e., the inability of users to properly determine fit from the existing packages. Since the problem to be solved was not perceived prior to the present invention, those skilled in the art would have no reason to provide a solution to a problem of which they are unaware.

The combined disclosures of *Murphy*, *Ovadia* and *Aylott* therefore fails to teach or suggest that “one of the longitudinal ends of each of said at least two of said artificial fingernails is arranged substantially perpendicularly to said bottom surface and faces said transparent portion on the front of said package”, and independent claims 1, 14 and 18 are deemed to be allowable.

Dependent claims 3-13, 15-17, and 19-20 are allowable for at least the same reasons as are independent claims 1, 14, and 18, as well as for the additional recitations contained therein.

It is believed that no additional fees or charges are required at this time in connection with the present application. However, if any additional fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,  
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